

DOCKET NO: 5244-0092-002



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
TETSURO MOTOYAMA, ET AL. : EXAMINER: TRAN, M.
SERIAL NO: 09/311,148 :
2ND RCE FILED: OCTOBER 2, 2003 : GROUP ART UNIT: 2179
FOR: APPLICATION UNIT :
MONITORING AND REPORTING :
SYSTEM AND METHOD :

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In reply to the Examiner's Answer of May 5, 2005, the present Reply Brief is submitted.

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS

The Appeal Brief filed January 26, 2005, sets forth in detail applicants' positions to the allowability of each of the pending claims in the present application. The present Reply Brief addresses comments set forth in the Examiner's Answer of May 5, 2005.

First, applicants note that from the Examiner's Answer the entire basis for the outstanding rejection of the claims based on the combination of teachings in U.S. patent 5,566,291 to Boulton et al. (herein "Boulton") in view of U.S. patent 6,433,802 to Ladd is completely unclear. That is, it is unclear how the noted combination of teachings addresses *all* of the claim limitations.

The claims are directed to a system and method for monitoring a user's usage of an operation panel of an image forming device. For example, which buttons on an operation panel of an image forming device a user presses is directly monitored in the claimed invention.

The basis for the outstanding rejection set forth in the Examiner's Answer is completely unclear and inconsistent as to how basic claimed features are met by the applied art.

First, the basis for the rejection appears to cite Boulton to disclose an interface of a target application including a plurality of operations to be selected by a user, and the basis for the outstanding rejection goes to detail how Boulton enters a feedback mode to create a feedback record. The basis for the outstanding rejection then recognizes that the only deficiency in Boulton is in the "step of automatically upon start-up of the target application without the user directly starting a monitoring program".¹

Applicants first note the cited teachings in Boulton do not even address "directly monitoring user selections of a plurality of operations of an interface". In the claimed

¹ Examiner's Answer of May 5, 2005, page 4, last four lines.

invention, e.g., what buttons a user presses on an operation panel of an image forming device are directly monitored. Boulton does not teach or suggest such a feature, as was argued in the filed Appeal Brief.

In response to such arguments in the Appeal Brief the outstanding Office Action inexplicably now states “[h]owever, the Examiner relies on Ladd (not Boulton) for the feature of directly monitoring user selections of a plurality of operations on an interface.”²

That statement in the outstanding Office Action is not understood as at no portion in the statement of the rejection is Ladd cited to teach such features. No portion in Ladd is even alluded to as disclosing such claimed features.

The basis for the rejection in the Examiner's Answer appears to accept that Boulton does not teach the above-noted claim features, and now appears to cite Ladd for such teachings, but does not cite any teachings in Ladd with respect to such features. It is also clear, however, from even a cursory review of Ladd that Ladd does not in fact disclose such features.

Ladd is directed to a parallel programming development environment in which a parallel application can be monitored. Ladd does not teach or suggest, nor does the Office Action even attempt to cite teachings in Ladd directed to, directly monitoring user selections of operations on an operation panel of an image forming device.

Simply, it is unclear how the rejection in the Examiner's Answer is even addressing that above-noted claim feature as apparently both or neither of the teachings in Boulton and Ladd are directed to such a feature.

In any event, for the reasons set forth above and in the filed Appeal Brief clearly Boulton and Ladd do not teach or suggest such a feature, nor could they teach such a feature.

² Office Action of May 5, 2005, page 7, lines 8-10.

Moreover, applicants reiterate that there is no possible way to combine the teachings in Ladd and Boulton in a way to meet the claim limitations, and there is no incentive or motivation to even combine the teachings of Boulton and Ladd in any manner.

Boulton is directed to a method for implementing a user feedback. Specifically, in Boulton a user can activate an enter feedback mode and can then type in comments to provide as feedback of usage of an interface. Such teachings are clearly different from the claimed features that are directed to directly monitoring each selection of a user interface of an image forming apparatus by a user. Further, the teachings of a parallel programming development in Ladd have no relevance whatsoever to the teachings in Boulton. Monitoring a parallel application in Ladd is completely irrelevant to allowing a user to type in feedback comments as in Boulton.

One stated motivation to combine such teachings of Boulton and Ladd in the Examiner's Answer is "the motivation being to make it easy for the user by not requiring him to directly execute a specific monitoring program as taught by Ladd".³

That statement in the outstanding Office Action does not appear to make any sense whatsoever.

The entire objective of the device of Boulton is to allow a user to type in feedback comments. In Boulton that feedback is the monitoring, and thus arguing it is possible to not require that feedback in Boulton and still achieve the feedback operation of Boulton defies any sense of logic.

Stated another way, the entire objective of the device of Boulton is that a user has to type in feedback comments, in Boulton that is the monitoring. It is unclear how one of ordinary skill in the art could modify such teachings to not require the user to execute the "monitoring program" as the monitoring program is the typing in of comments in Boulton.

³ Examiner's Answer of May 5, 2005, page 5, lines 12-13.

Further, the entire feature of automatically monitoring a parallel application in Ladd has no relevance to Boulton as Boulton is not directed to operating applications in parallel. Clearly the cited art to Boulton and Ladd are completely unrelated and any attempt to combine the teachings in the manner suggested in the Office Action is nonsensical at best.

One other statement in the Examiner's Answer to support the combination of teachings is as follows: "However, in the same field of monitoring program, Ladd teaches the feature of 'a monitoring operation without a user starting a monitoring program'".⁴

With respect to the above statement, applicants note that Boulton and Ladd are not at all directed to a same monitoring program. Boulton does not monitor anything. Boulton simply allows a user to input feedback comments. Ladd, completely unrelatedly, monitors a parallel application. The basis for the outstanding rejection evidently takes the position that anything that can broadly be termed "monitoring" is in the same field of endeavor; obviously such a position is untenable as many different types of monitoring operations in many different fields and in many different activities do not give rise to motivations to combine reference teachings.

⁴ Examiner's Answer of May 5, 2005, page 8, lines 18-20 (original emphasis).

In view of these foregoing comments, and in addition to the comments presented in the Appeal Brief filed January 26, 2005, applicants respectfully submit that clearly the outstanding rejection based on the combination of teachings Boulton in view of Ladd does not render obvious all of the claimed features, and thus the outstanding rejection must be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648
Surinder Sachar
Registration No. 34,423

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)
JKK/rac

!:\ATTY\SNS\5244\52440092\52440092US-RB.DOC

Docket No. 5244-0092-2



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Tetsuro MOTOYAMA, et al.

SERIAL NO: 09/311,148

GAU: 2179

2nd RCE FILED: OCTOBER 2, 2003

EXAMINER: TRAN, M.

FOR: APPLICATION UNIT MONITORING AND REPORTING SYSTEM AND METHOD

REQUEST FOR ORAL HEARING

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicant's representative hereby respectfully requests that an Oral Hearing be scheduled in the above-identified application.

A credit card payment in the amount of \$1,000.00 to cover the fee is enclosed herewith and any further charges may be made against the Attorney of Record's Deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink that reads "Surinder Sachar".

James J. Kulbaski
Registration No. 34,648

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 05/03)

Surinder Sachar
Registration No. 34,423

05/31/2005 HAL111 00000033 09311148
01 FC:1403 1000.00 0P